

REMARKS

Claims 21-25 and 27-44 are currently pending in the application. By this amendment, claims 21, 29, 33, 35, 36, 38, and 44 are amended and claim 26 is canceled for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at pages 4-7 of the specification. Reconsideration of the rejected claims in view of the following amendments and remarks is respectfully requested.

Examiner Interviews

Applicants appreciate the courtesies extended by the Examiner during the telephonic interviews with Applicants' undersigned representative. During the telephonic interview conducted on May 7, 2008, the rejection of independent claim 29 under 35 U.S.C. §101 was discussed. The Examiner indicated that the instant amendments to claim 29 overcomes the rejection under 35 U.S.C. §101.

During the telephonic interview conducted on June 11, 2008, the rejection of claims 21, 29, and 35 were discussed. This telephonic interview was followed by another telephonic interview on June 16, 2008, to further discuss the rejection of claims 21, 29, and 35. The Examiner indicated that the instant amendments to claims 21, 29, and 35 overcomes the rejection under 35 U.S.C. §103(a).

Amendments to the Claims

Applicants have amended claims 21, 29, 33, 35, 36, 38, and 44. Applicants have also canceled claim 26. Applicants are not conceding in this application that the originally presented claim is not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter noted by the examiner. Applicants respectfully reserve the

right to pursue these and other claims in one or more continuations and/or divisional patent applications.

35 U.S.C. §101 Rejection

Claims 29-34 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. This rejection is respectfully traversed.

To advance prosecution, Applicants have amended claim 29 to recite, in pertinent part:

Apparatus for tailoring information in a combination of hardware and software to characteristics of an information user, the apparatus comprising:
a content database...

Applicants submit claim 29, as amended, is directed to statutory subject matter and is representative of the language discussed in the Examiner interview. Accordingly, Applicants respectfully request the rejection over claim 29 be withdrawn.

Applicants note that claims 30-34 depend from independent claim 29 and are thus directed to statutory subject matter based on their dependencies from independent claim 29. Accordingly, Applicants respectfully request the rejection over claims 30-34 be withdrawn.

35 U.S.C. § 103 Rejections

Claims 21, 24, 26, 28-30, 33 and 34 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,313,921 issued to Kadowaki ("Kadowaki") in view of "Forecast Pro." Claims 22, 31, 32 and 35-44 were rejected under 35 U.S.C. § 103(a) over Kadowaki in view of Forecast Pro, and further in view of U.S. Patent No. 6,064,980 issued to Jacobi, et al. ("Jacobi"). Claim 27 was rejected under 35 U.S.C. § 103(a) over Kadowaki in view of Forecast Pro and Jacobi, in further view of U.S. Patent No. 6,556,963 issued to Tetzlaff ("Tetzlaff"). Claims 23 and 25 were rejected under 35 U.S.C. § 103(a) over

Kadowaki and Forecast Pro in view of U.S. Patent No. 6,044,376 to Kurtzman II ("Kurtzman"). These rejections are respectfully traversed.

In order to reject a claim under 35 U.S.C. §103(a), the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142. Applicants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

Overview of the Present Invention

With the rapid growth of the Internet, the quantity of information that many people encounter while on the Internet has increased. With this increase of information, it is important to tailor the content of information to meet the needs of Internet users. The present invention tailors information on the Internet in response to characteristics of an Internet user to minimize information overload.

More specifically, Internet user's or automated devices interact with an application program, which requests information from a server by sending a message over the Internet. This message includes a request object, which is a structure capable of transporting a profile element. A request object devoid of profile elements may be sent to an input logic, which receives the input logic and accesses a profile database

through a profile database proxy in order to obtain profile elements relating to the user.

One or more of the profile elements may be incorporated into the request object, which can be passed to an arbiter. The arbiter may use the profile elements to select a personalization engine, which may be used to identify personalized content objects for the user. These personalized content objects are selected from a content database via a content database proxy and sent to the user as part of a response to the user's request for information, thereby providing tailored information to the user based on the user's characteristics.

Rejection of Claims 21 and 29 in View of Kadowaki and Forecast Pro

Claim 21 recites, in pertinent part:

- ... passing a request object excluding any profile elements to an input logic;

- receiving the request object and accessing a profile database through a profile database proxy, the profile database containing profile elements that are known to a server but originally excluded from the request object, the profile elements including a user name, network ID, and user interaction history;

- incorporating the request object with relevant profile elements of the profile elements found in the profile database;

- passing the request object with the relevant profile elements to an arbiter;

- actively selecting, by analysis of the relevant profile elements, a personalization engine, which is configured to provide an optimal performance, from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the relevant profile elements;

- accessing a content database via a content database proxy to retrieve a personalized content object identified by the personalization engine selected by the arbiter; and

- passing with the arbiter the personalized content object to an application program,

- wherein the arbiter comprises an expert system that is one of rule based, model based, and knowledge based.

Claim 29 recites, in pertinent part:

- ... a content database;
- an input logic for receiving a request object excluding any profile elements and accessing a profile database through a profile database proxy, the profile database containing profile elements that are known to a server but originally excluded from the request object, the input logic configured to incorporate into the request object any relevant profile elements of the profile elements found in the profile database including a user name, network ID, and user interaction history;
- an arbiter for accepting and analyzing a request object having the relevant profile elements, which is passed by the input logic, the arbiter refining and altering a selection based on a number and type of at least one of the profile elements contained in the request object;
- a plurality of personalization engines for selecting at least one personalized content object from the content database;
- the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database via a content database proxy; and
- the arbiter passing the personalized content object to an application program,
- wherein the arbiter comprises an expert system that is one of rule based, model based, and knowledge based.

While Applicants do not agree that claims 21 and 29 are obvious in view of Kadowaki and Forecast Pro, Applicants have amended claims 21 and 29 to advance prosecution. Applicants submit the instant amendments were discussed during the June 16, 2008 Examiner Interview, wherein the Examiner indicated that the instant amendments overcome the art of record. Accordingly, Applicants respectfully request the rejection of claims 21 and 29 be withdrawn.

Claims 22-28 and 30-34 are dependent claims, depending from distinguishable independent claims 21 and 29, respectively. For these reasons, Applicants submit that these claims are allowable for at least the reasons discussed above with respect to independent claims 21 and 29. Moreover, the applied references do not disclose many of the additional features recited in these dependent claims. Accordingly, Applicants

respectfully request the rejection over claims 22-28 and 30-34 be withdrawn.

Rejection of Claim 35 in View of Kadowaki, Forecast Pro. and Jacobi

Claim 35 recites, in pertinent part:

- ... passing a request object excluding any profile elements to an input logic;
- receiving the request object and accessing a profile database through a profile database proxy, the profile database containing profile elements that are known to a server but originally excluded from the request object, the profile elements including a user name, network ID, and user interaction history;
- incorporating the request object with relevant profile elements of the profile elements found in the profile database;
- passing the request object with the relevant profile elements to an arbiter;
- selecting with the arbiter a personalization engine by analysis of the relevant profile elements;
- selecting with the personalization engine a personalized content object to tailor information provided to the user, wherein the personalized content object is stored in a content database and accessed via a content database proxy; and
- using the arbiter for on-line shopping,
- wherein the arbiter comprises an expert system that is one of rule based, model based, and knowledge based.

While Applicants do not agree that the applied references include the features of the claimed invention, Applicants have amended claim 35 to advance prosecution. Applicants submit claim 35, as amended, is not obvious in view of the applied art and that the amendments to claim 35 were discussed during the Examiner Interview, wherein the Examiner indicated that the instant amendments overcome the art of record. Accordingly, Applicants respectfully request the rejection of claim 35 be withdrawn.

Claims 36-44 are dependent claims, depending from distinguishable

independent claims 35. For this reason, Applicants submit that these claims are allowable for at least the reasons discussed above with respect to independent claim 35. Moreover, the applied references do not disclose many of the additional features recited in these dependent claims. Accordingly, Applicants respectfully request the rejection over claims 36-44 be withdrawn.

No Suggestion or Motivation to Combine the Applied References

Applicants submit there is no suggestion or motivation to combine the references used to reject independent claims 21, 29, and 35. More specifically, Applicants submit Kadowaki is directed to an image forming system, i.e., a printing system, which allows a user to personalize a print job. Exemplary personalizations include allowing a user to store specific fonts, cover sheets, pictures, etc., which may be used whenever the user prints a job.

In contrast, Forecast Pro is directed to software that companies can use to improve planning, cut inventory costs, and decrease stockouts by improving the accuracy of their forecasts. In particular, Forecast Pro attempts to forecast business solutions by entering inputs into an expert system and chooses an algorithmic model, e.g., Box-Jenkins, Dynamic Regression, etc., to apply to the inputs. The result of the algorithmic model is a business forecast. However, the business forecasting technology articulated in Forecast Pro has little or nothing to do with the personalizing print jobs technology described in Kadowaki. Accordingly, Applicants submit there is no suggestion or motivation to combine Forecast Pro and Kadowaki.

As to claim 35, Applicants submit Jacobi is directed to a system and method for collecting ratings from users. More specifically, Jacobi allows a first user to rate a list of items and stores the ratings with other ratings in a database. Jacobi then filters the rated items to create a new list of items, which is presented to second, third, and/or fourth users for ranking. However, Applicants submit collecting ratings has little or nothing to do with personalizing print jobs, as taught in Kadowaki. Moreover, Applicants

submit collecting ratings has little or nothing to do with the business forecasting technology articulated in Forecast Pro. Accordingly, Applicants submit there is no suggestion or motivation to combine any one or more of Jacobi, Forecast Pro, and Kadowaki.

Accordingly, Applicants submit there is no suggestion or motivation to combine the references used to reject independent claims 21, 29, and 35. Therefore, Applicants assert the Examiner has failed to establish a *prima facie* case of obviousness. As such, Applicants respectfully request the rejection of claims 21-44 under 35 U.S.C. 103(a) be withdrawn.

CONCLUSION

Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0457.

Respectfully submitted,
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